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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.</td><td>Applicant(s)</td><td></td></tr>
<tr><td>09/240,250</td><td>BOESCH, BRIAN</td><td></td></tr>
<tr><td></td><td>Examiner</td><td>Art Unit</td><td></td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *the amendment dated on 8/07/07*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *80-96* is/are pending in the application.

    4a) Of the above claim(s) *84,86 and 88* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *80-83,85,87 and 89-96* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is the answer to the amendment filed on 8/07/2007, which paper has

been placed of record.

2.   Claims 80-83, 85, 87, and 89-96 are pending in this application.

Response:

3.   The examiner disagrees that the applicant asserts that the examiner relies on hindsight bias

to examine this application (see Page 10 of 12, line1-2); the claimed subject matter is well-known

– The examiner retrieved the best cited prior art that suggests the critical functions in business

transaction that claimed.

In the REMAKRS (1/29/2007), applicant argues that "Stein's reference does not teach or

suggest a consumer server at all"., the examiner submits that a server is merely a place/a database

to have data/information about a consumer; therefore, this limitation is not an inventive concept

against cited prior art. Applicant goes on "There is nothing in this reference that suggests that a

consumer can store registration information at a consumer information server, and then use that

information to conduct transactions with a plurality of merchants, without having to register with

each merchant" the examiner reminds applicant that because this kind of information verification

(a form of private information retrieval) is not inventive – actually very well-known, the examiner

did not explicitly provide a piece of reference for this limitation; one very well-known example is

"a credit report" to use for buying a house – this piece of informative paper is used by many home

builders for transactions with customers (this information can be retrieved on-line (electronically)

or manually (not electronically). On page 6, paragraph 5, the examiner wants to point out that

claimed "consumer information server" is merely an "trust" electronic database of consumers that

has been widely known in business (PayPal is another example) (see Perkowski., US Pub

20020004753 "Detail Description Paragraph:

[0237] Manufacturers desiring to register their consumer products and product-related Web pages within the UPC

REQUEST.TM. Database would pay a one-time Manufacture Registration Fee, based on volume of sales. An annual

maintenance fee may be desired or necessary. Minimally, such fees should cover the cost of the EDI and UPC/URL

Database Management software (and updates) automatically downloaded to each manufacturer upon registration. Such

Web-based EDI software enables manufacturers to easily manage the UPC numbers and Web page URLs associated

with their changing product lines, and automatically transmit such information to the UPC REQUEST.TM.

Manufacturer/Product Registration Subsystem in order that the UPC REQUEST.TM. Database Management Subsystem

is periodically updated.

Detail Description Paragraph:

[0244] For example, in the illustrative embodiments described hereinabove, separate databases are maintained by each

data-synchronized IPD Server for (i) registered products within the system, and (ii) non-registered products within the

system. Notably, the reasons for using a dual database design of this sort would be based largely on economics, namely:

only those companies who have paid the required maintenance (or registration) fees get their products and linked-URLs

"registered" with the system, whereas non-paying companies and organizations do not get their products and linked-

URLs registered with the system, regardless of how such product-URL information is ascertained (e.g. by solicitation

versus data-mining).

Detail Description Paragraph:

[0245] Thus it is contemplated that in some embodiments of the present invention, each IPD Server will be designed to

maintain only a single database for maintaining product-URL information currently available on the Internet. In such

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embodiments of the present invention, the concept of "non-registered" products will be altogether avoided, since the

system implementation and administration may be designed to not require companies to pay maintenance (or

registration) fees in order that their products and linked URLs are registered with the IPI system. Instead, some

alternative income producing scheme will be used in such embodiments of the present invention (e.g. user fees,

subscription fees, Internet browser-licensing fees, etc.) for system maintenance and administration.

Detail Description Paragraph:

[0247] In order that the system hereof can be used to find information pertaining to large products such as automobiles,

motorcycles, skidoos, farm machinery, boats, etc., the present invention also contemplates assigning UPC numbers to

such products and attaching, embossing or otherwise embodying the same on an accessible surface thereof. Also, the

UPC label can be printed on all instruction booklets and/or operating manuals normally provided with the product. In

this way, information related to any particular product that is posted anywhere on the Internet and linked to URLs

registered with the IPD Servers of the system hereof can be readily found using the uniquely assigned UPC number

assigned thereto by the manufacturer at the time of sale. Notably multimedia information about such products can be

most helpful in regard to the operation, repair and servicing of such products.

and Claim 13.

An Internet-based consumer product information delivery system comprising: means for enabling

manufacturers and their agents to link (i.e. relate), manage and update within a database, the UPC (and/or UPC/EAN)

numbers on their products and the Uniform Resource Locators (URLs) of HTTP-encoded documents containing

particular kinds of consumer product-related information published on the Internet by said manufacturers, their agents

and/or third parties; and means for enabling consumers, in retail stores, at home, in the office and on the road, to access

said consumer product-related information from said database, using said UPC (and/or UPC/EAN) numbers and/or by

scanning UPC (or UPC/EAN) bar code symbols encoded with said numbers.").

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The invention's concept is analyzed with a pending <u>comprehensive claim</u> 80; the examiner's

position is this claim is broadly taught about getting related information before doing an electronic

transaction – a quite familiar task for doing business:

<u>Claim 80</u>:   A method for conducting electronic transactions over a network,

comprising:

at a merchant computer:

sending, to a consumer computer, an electronic mail message associated

with an electronic transaction, the electronic mail message including a link

to a consumer information server; and

at the consumer information server:

receiving, from the consumer computer, a connection request based on the

link,

> <u>*determining whether a consumer using the consumer computer is registered with the consumer*</u>
> <u>*information server,*</u>
> <u>*if the consumer is not registered with the consumer information server*</u>
> *sending, to the consumer computer, a request for registration information,*

This above condition "if" is very well-known in business – i.e., if

needing consumer info., asking for them; a different way to have an answer

to those above 2 paragraphs.

receiving, from the consumer computer, registration information in

response to the request, the registration information including a consumer

identification number, and storing the registration information.

The examiner respectfully submits that above claim is <u>merely about a very familiar</u>

interactive use (e.g., using Internet), comprising steps:

-       sending to a customer a message including a link to a server; and

-       customer receiving a connection request (based on the link - just click a message's

hyperlink),

-       server sending to that consumer a request form (e.g., for well-known registration

information, or for merchandise warranty etc.),

-       customer receiving registration information, and

-       that register information are stored.

This claim's concept is already suggested by the cited references; although the amendment
for this claim adds more explanation for a server, these added steps are well-known to make sure
a "basic" verification is made in the process – this added feature is not inventive; i.e.,
"determining whether a consumer using the consumer computer is
registered with the consumer information server,
      if the consumer is not registered with the consumer information server
". send a requirement for registration.

Similar amended phrase is added to independent claim 93 – this added feature is not
inventive.

The cited art is not necessarily spell-out that basic step.

In page 3 of the REMARK, applicant argues a very well-known task: Kuzma does not

disclose "sending, to a consumer computer, an electronic mail message associated with an

electronic transaction, the electronic mail message including a link to a consumer information

server, as required by the claim" the examiner respectfully submits that it is not necessary Kuzma

MUST disclose/spell-out exactly what claim, Kuzma suggests that idea (a link is merely a

domain/address of an email).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office Action:

(a)   *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

5.   Claims 80-83, 85, 87, and 89, 90-92, 94-96 are rejected under 35 U.S.C. § 103(a) as

being unpatentable over Stein et al. (US Pat. 6,246,996), in view of Kuzma (US Pat. 5,771,355),

and further in view of Perkowski., (US Pub 20020004753).

The examiner submits that besides old and well-known claimed limitations, the only

"arguable" limitation in independent claims describing: sending a message to a server, that server

would forward said message comprising a computer address, then accessing that address. This

limitation has been done in computer processing, because instead of putting a URL (a computer

address) in an email, a user can type that address in "GO TO" block on a Netscape website to

access that same address OR the same method has been INHERENTLY DONE by any computer

server. Such claims' limitations have been widely used in Internet accessing, and those Internet

widely used features are very convenient for a user because it directly let a user immediately

access wanted computer's sites. (Another example is a server letting a user accesses to its site,

then inside the server there is an icon/address that matches the user's need, then the user only

need to "click" to activate said wanted computer icon/address).

A. As to claim 80: Stein et al. teach a method for conducting electronic transactions over a

network (see Stein et al., Fig.1).

In addition, Perkowski suggests about using a customer information server to provide

information to a merchant or another merchant; obviously a customer MUST register to submit

these customer-related information to that server (see Perkowski, claim 13).

at a *merchant computer*,

sending, to a consumer computer, an electronic mail message associated with an electronic

transaction, the electronic mail message including a link to a consumer information server (this is

merely a structural communication between a seller (see Stein et al., Fig.1 - ref.28) and an

Internet server (see Stein et al., INTERNET of Fig.1 and Fig.7, ref.12);

Although Stein may not disclose expressly an act of activating a hypertext including in an

email message as claimed; Kuzma clearly suggest that idea (See Kuzma, col.12 line 65 to col.13

line 38);

The applicant claims that: at the consumer information server (e.g., an Internet server as

in Stein reference, Fig.1 ref. 12);

- *receiving, from the consumer computer, a connection request based on the link, sending, to*

  the consumer computer, a request for registration information (Stein teaches a structure for

  exchanging communication between a buyer (ref.20) and an INTERNET server (ref.12)

  *including for registration, see **Stein**, Figs. 1, and 8);*

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- *receiving, from the buyer/consumer, <u>registration information</u> in response to the request, the registration information including a <u>consumer identification</u> number, (Stein teaches a structure for all transaction communication between a seller (ref.28) and an Internet server (ref.12), see **Stein**, Fig. 8);*

Above limitations are already taught by Stein and Kuzma; they merely use structural connections between 2 parties, and a middle-man (a server/Internet) that teach the claimed steps of claim 80, including registration and consumer identification. This is old and well-known interactions in Internet for communication purpose between different parties.

Buyer's computer (see Stein Fig.1, ref.20) often stores or prints out registration information page as evident of <u>an electronic transaction</u> that could be used later.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine those practices of Stein et al., Kuzma, and Perkowski to activating a hypertext including in an email message because this step gives an advantage of exchanging short email messages but containing all related information by using a hypertext link.

B. As to claim 81: The rationales and reference for a rejection of claim 80 are incorporated.

Stein et al. teach a method for conducting electronic transactions over a network through email messages, wherein the e-mail message can includes different kinds of information, including information about a transaction (see Stein Fig.1).

It would have been obvious to one of ordinary skill in the art that it is old and well-known that an e-mail message can include many different kinds of specific information including "purchase information associated with an electronic transaction"; moreover, this particular kind of

information is classified as <u>non-functional descriptive material</u> that do not contribute to an inventive concept of distributing an email message.

C. As to claim 82: The rationales and references for rejection of claim 81 are incorporated.

Stein et al. teach a method for conducting electronic transactions over a network (see Stein Fig.1), wherein electronic communications include email communications having different kinds of information including an URL address.

It would have been obvious to one of ordinary skill in the art that it is old and well-known that purchase information can include many different information including "a merchant computer uniform resource locator (URL)" as claimed; furthermore, artisans recognize that a computer address (an URL) is standardized necessary to identify who sell/have a particular product (e.g., the use of cookie or banner that corresponding to a specific URL); this particular kind of information is classified as non-functional descriptive material that do not contribute to an inventive concept of distributing an email message.

D. As to claim **83:** The rationales and references for a rejection of claim 80 are incorporated.

Stein et al. teach a method for conducting electronic transactions over a network (see Stein Fig.1); the examiner submits that an e-mail message inherently <u>includes a connection software/instructions to generate a connection request</u> on a consumer computer – please note that a specific information "to generate a connection request" merely to a specific intent of use (e.g., The most common purpose for computer spamming is advertising. Goods commonly advertised in spam include pornography, computer software .etc.).

It would have been obvious to one of ordinary skill in the art that it is old and well-known

that an e-mail message may include different kinds of information including "a connection

software for a connection request" (e.g., a cookie or a computer link, if a computer user click

that, the embedded software would be executed) for an email reader's convenience.

F. As to claim 85: The rationales and references for a rejection of claim 84 are incorporated.

Stein et al. teach a method for conducting electronic transactions over a network (see

Stein et al., Fig.1), wherein the connection request may includes an Internet address of the

consumer information server.

Please note that include an access request in an email message (as claimed) is considered

as including extra specific information – non-functional descriptive material (e.g., including an

URL address for completeness).

I. As to claim 92: The rationales and references for a rejection of claim 80 are incorporated.

Stein et al. teach a method for conducting electronic transactions over a network (see

Stein et al., Fig.1), comprises a step of sending an electronic mail to consumer.

It would have been obvious to one of ordinary skill in the art at the time this invention was

made that Stein and Kuzma suggest of inputting many different kinds of information including a

message that "indicating a registration information was stored" (this information is the most

updated information provided by a customer –, therefore, it is critical to a merchant for further

communication with that customer); furthermore, artisans recognize that an email response to tell

about a registration status is necessary to acknowledge a user about a completion process.

6. Claims 87, 89-90, and 93 are rejected under 35 U.S.C. § 103(a) as being unpatentable

over Stein et al. (US Pat. 6,246,996), in view of Kuzma (US Pat. 5,771,355), and in view of

Wiser et al. (US Pat. 6,385,596).

A. As to claim 87: The rationales and references for a rejection of claim 86 are incorporated.

Stein et al. teach a method for conducting electronic transactions over a network,

inherently using an identification such as registration information.

Stein et al. do not disclose that information includes a consumer passphrase

However, Wiser et al. teach a consumer passphrase as input information (see **Wiser** et

al., col.19 lines 50-59).

It would have been obvious to one of ordinary skill in the art to combine Stein et al.,

Kuzma, and Wiser et al. to use passphrase in input information because including in a message a

specific consumer information such as a selected passphrase would increases a flexible option and

security for an Internet transaction.

C. As to claim 89: The rationales and references for rejection of claim 88 are incorporated.

Stein et al. teach a method for conducting electronic transactions over a network (see Stein

Fig.1), wherein the e-mail message can includes different kinds of information including a consumer

shipping address (a non-functional descriptive material).

It would have been obvious to one of ordinary skill in the art that it is old and well-

known that registration information may include a specific information such as including a

consumer shipping address (a Internet merchant must ask this question for delivery purpose).

D. As to claim 90: The rationales and references for rejection of claim 89 are incorporated.

Stein et al. teach a method for conducting electronic transactions over a network (see Stein

Fig.1).

It would have been obvious to one of ordinary skill in the art that it is old and well-known that an email message can include many different kinds of information including a message that "a registration information includes a consumer shipping method"; furthermore, artisans recognize that in an email response, it is necessary to clearly state/"mark"/"select" a shipping option (although this kink of question may be asked in registration stage or before checking out, it is clear that a merchant includes this kind of question - See legal precedents cited in "Rearrangement of Parts" in MPEP 2144.04, e.g., by UPS ground, by US Postal Service, or by air using Fed. Express as shipping options).

E. As to claim 93: All the limitations of this claim are already analyzed above, and are rejected with the rationales and references set forth in claims 80-92, as shown above.

It would have been obvious to one of ordinary skill in the art that the combination of Stein's structural configuration, Kuzma, Perkowski, and Wiser's teachings to suggest about an interactive, and secured email communication as claimed since cited references are in the same field of business transaction in Internet that would be known by artisans for interactive communications between 3 parties: a merchant, a customer, and a server including selecting a link according to a particular computer address (please note that selecting/clicking a non-functional descriptive material such as a link would directs to a corresponding computer address to do a task such as a registration .etc., Wesinger, Jr et al. (US Pat. 5,778,367) already suggest this configuration (see Wesinger Jr. et al., Fig.5, and 3:27-30, 4:58-67).

E. As to claims 94-96: The examiner submits that these new claims have no inventive concept, because of containing non-functional descriptive material that does not change the claimed

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step(s): i.e.,

For claim 94: a message includes purchase information associated with the electronic transaction

– this is obvious (e.g., a receipt having both purchase information and a transaction number).

For claim 95: a purchase information includes a merchant computer uniform resource locator –

this is obvious (e.g., a receipt containing both purchased items and having a merchant's online

address).

For claim 96: a mail message includes connection software to generate the connection request –

this is obvious because attachment (that connection software) could be easily included in a mail

message for use.

Stein et al. teach a method for conducting electronic transactions over a network (see

Stein Fig. 1), wherein the e-mail message can includes different kinds of specific information such

as consumer payment information (non-functional descriptive material).

It would have been obvious to one of ordinary skill in the art that it is old and well-

known that registration information can include many different information including consumer's

payment info. (such as a choice of payment made by a credit card –

MASTER/VISA/AMERICAN EXPRESS, or a payment make by a personal check); this

particular kind of information is classified as non-functional descriptive material that do not

contribute to a patentability of the subject matter of communications about a transaction in the

Internet.

Conclusion

7.   Claims 80-83, 85, 87, and 89- 96 are not patentable. THIS ACTION IS MADE FINAL

because the submitted arguments are unpersuasive. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 9:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an

effort to help advance prosecution; otherwise any new claim language that is introduced in an

amended or new claim may be considered as new matter, especially if the Application is a Jumbo

Application.

/CUONG H. NGUYEN/
Primary Examiner
Art Unit 3661